

AMENDMENT UNDER 37 C.F.R. § 1.116
Appln. No. 09/977,996
Docket No. Q66764

REMARKS

Claims 1, 2, and 6-10 are all the claims pending in the application. Claims 3 and 4 have been canceled.

Claims 1-4 and 6-10 are rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Aikawa et al. (US 6,435,702) in view of Temme et al. (US 6,349,635) and Willems et al. (US 6,194,497).

As an initial matter, all of the recitations of dependent claim 3 have been added to independent claim 1. Applicants respectfully request the Examiner to withdraw the rejection of independent claim 1 (previously dependent claim 3) at least because the combination of Aikawa, Temme, and Willems does not teach or suggest all of the claim recitations. For example, the combination of Aikawa, Temme, and Willems does not teach or suggest the claimed vehicle lamp in which the front lens contains a base material having an antistatic agent disposed within the base material, the initial surface resistance value of the front lens being $1 \times 10^{13} \Omega/\text{cm}^2$ or less, wherein a portion of an extension reflector is disposed adjacent to the front lens, and a metal film is provided on the extension reflector.

According to the rejection, the Examiner acknowledges that the combination of Aikawa and Temme does not teach or suggest that the front lens contains a base material having an antistatic agent disposed within the base material or that the initial surface resistance value of the front lens being $1 \times 10^{13} \Omega/\text{cm}^2$ or less. Therefore, the Examiner looks to the antistatic resin of Willems in an attempt to make up for this deficiency. Willems, however, merely discloses a

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anti-static composition and fails to teach or suggest that the initial surface resistance value of the front lens is $1 \times 10^{13} \Omega/\text{cm}^2$ or less.

It is the Examiner's position that it would have been obvious to obtain a front lens with a initial surface resistance value of $1 \times 10^{13} \Omega/\text{cm}^2$ or less in light of *In re Boesch and Slaney*, 205 USPQ 215 (CCPA 1980). Specifically, the Examiner alleges that he considers determining the optimum value of the required conductivity to obtain minimum accumulation to be a "result of due experimentation". Office Action dated March 22, 2004 at page 5. However, there is no evidence in any of the applied references that the initial surface resistance value of the front lens is considered by one skilled in the art as a result effective variable with respect to preventing accumulation for a lamp in which a portion of an extension reflector (provided with a metal film) is disposed adjacent to the front lens. See MPEP § 2144.05.II.B.

As discussed in the present specification, in a lamp in which a portion of an extension reflector (provided with a metal film) is disposed adjacent to the front lens, a constant discharging from the front lens to the extension generates "tree marks". Applicants have identified that by providing a front lens with an initial surface resistance value of $1 \times 10^{13} \Omega/\text{cm}^2$ or less, the generation of tree marks is prevented. Specification at 12:10-20.

Furthermore, it is impermissible for the Examiner to rely on *In re Boesch* as the sole support for a rejection at least because Applicants have discovered values for initial surface resistance through which the ability to prevent "tree marks" is obtained. See MPEP § 2144.04 ("If Applicant has demonstrated the criticality of a specific limitation it would not be appropriate to rely solely on case law as a rationale to support an obviousness rejection.").

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As such, Applicants respectfully request the Examiner to withdraw the rejection of claim

1. In addition, Applicants respectfully request the Examiner to withdraw the rejection of claims 2 and 6-10 at least because of their dependency from claim 1.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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